REMARKS

I. General

Claims 1-29 were pending in the present application, and all of the pending claims are rejected in the current Office Action (mailed April 20, 2005). The outstanding issues raised in the current Office Action are:

- Claim 1 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite; and
- Claims 1-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,490,626 issued to Edwards (hereinafter "*Edwards*") in view of U.S. Patent No. 5,572,673 issued to Shurts (hereinafter "*Shurts*").

In response, Applicant respectfully traverses the outstanding claim rejections, and requests reconsideration and withdrawal thereof in light of the remarks presented herein.

II. Rejection under 35 U.S.C. § 112

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph for indefiniteness with regard to the terms "inconsistent sensitivity labels" and "arbitrary incomparable." The Office Action asserts that the terms "inconsistent sensitivity labels" and "arbitrary incomparable" are relative terms. Applicant disagrees. First, "inconsistent sensitivity labels" is not a relative term. This does not, for instance, recite a degree of inconsistency. Instead, this recites that the sensitivity labels are inconsistent.

Similarly, the phrase "arbitrary, incomparable sensitivity labels" is not relative. The term "arbitrary" in this phrase is not relative. That is, it does not recite a degree of arbitrariness. Likewise, the term "incomparable" in this phrase is not relative. Paragraph 8 of the specification of the present application provides: "Two labels are considered incomparable if neither label dominates the other." Thus, in view of the specification, one of ordinary skill in the art would sufficiently understand the meaning of the term "incomparable" as used in claim 1.

The Office Action also asserts that "Applicant needs to define how the sensitivity labels, recited in claim 1, are comparable or not...." Page 2 of Office Action. The comma

between the terms "arbitrary" and "incomparable" in this phrase signals that both terms modify the recited "sensitivity labels". Thus, the claim does not recite that "incomparable" is arbitrary, but instead refers to arbitrary sensitivity labels, which are also recited as being incomparable.

Thus, the Office Action is incorrect in asserting that the language of claim 1 recites relative terms. As such, the rejection under 35 U.S.C. § 112, second paragraph is improper and should be withdrawn.

III. Rejection under 35 U.S.C. § 103

Claims 1-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Edwards* in view of *Shurts*.

Applicant respectfully asserts that *Edwards* is not a valid prior art reference for use in a § 103(a) rejection. As amended by the American Inventor's Protection Act of 1999 (the Act), signed on November 29, 1999, section 103(c) now states:

> (c) Subject matter developed by another person, which qualifies as prior art only under one or more of sub-sections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Section 4807 of the Act further provides that this new provision applies to any application filed on or after the date of enactment, November 29, 1999. The present application was filed January 27, 2004 as a continuation of Application Serial No. 09/418,285 filed October 14, 1999.

Edwards is available only as 35 U.S.C. § 102(e)-type prior art as to the present application. Further, at the time the invention of the present application was made, the present application and *Edwards* were owned by the same person. That is, at the time of the filing of the parent application (Application Serial No. 09/418,285) from which the present application is a continuation, both *Edwards* and such parent application were assigned to Hewlett-Packard Development Company.

In view of the above, 35 U.S.C. § 103(c) now provides that *Edwards* "shall not preclude patentability" of the claimed invention. Accordingly, the rejections of claims 1-29 should be withdrawn.

IV. Conclusion

In view of the above remarks, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10980679-2 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 482711495US in an envelope addressed to: M/S Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: July 18, 2005

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Respectfully submitted,

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